

Docket No. AB-165U

Remarks/Arguments

By way of the present amendment, applicant has amended paragraph [0053] of the specification to reflect the status of the referenced application Serial No. 09/624,130, filed 7/24/2000 which is now abandoned.

Applicant has added appropriately labeled text to the non-descript boxes of FIG. 5. A revised new drawing for FIG. 5 is submitted herewith along with an annotated sheet showing changes.

Applicant has herein amended Claims 1, 7, 10, 11 and 15, and withdrew Claims 12-14 and 23-26. Nineteen (19) claims remain pending in the application: Claims 1-11, and 15-22, of which claims 1 and 15 are independent. Applicant respectfully requests reconsideration of the pending claims, in view of the amendments above and comments below.

Election/Restrictions

Applicant herein affirms the election towards the invention set forth in Group I and the species involving the use of a leadless stimulator, related to claims 1-11 and 15-22. Applicant reserves the right to pursue the subject matter of Group II, claims 12-14 and claims 23-26 in a continuing application(s).

Double Patenting

The Examiner rejected Claims 1-11 and 15-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18 and 19 of U.S. Patent No. 6,735,475. Applicant has submitted herewith a Terminal Disclaimer which should overcome this rejection.

The Examiner also provisionally rejected Claims 1-11 and 15-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8, 14-16 and 22-31 of copending Application No. 10/081,820. In the event the indicated claims

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of the referenced copending Application No. 10/081,820 should issue, applicant has submitted herewith a Terminal Disclaimer which should likewise overcome this provisional rejection.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-11 and 15-22 under 35 U.S.C. 103(a) as being unpatentable over Schulman et al. (Pat. No. 6,185,452). The Examiner acknowledged that the Schulman et al. '452 patent did not explicitly discuss a method for treating *chronic* pain. However, with respect to Claim 1 and Claim 15 (the only independent claims remaining in the application), the Examiner indicated that the body of the claim could not be viewed as being limited to methods of treating chronic pain despite the language in the preamble of the claim that stated the invention was directed to a method of treating chronic pain. This is because the body of the claim, according to the Examiner, did not "give life, vitality and meaning to the preamble, and thus [the body] is not limited to methods for treating chronic pain."

It is respectfully submitted that the body of Claims 1 and 15, as amended concurrently herewith, now limits the invention to methods of treating chronic peripheral pain. For example, in Claim 1, now included in the steps that must be carried out to practice the claimed method is the step of "identifying a patient experiencing sensations of chronic peripheral pain". The claim is further amended to specify precisely what is meant by chronic peripheral pain. Thus, it is now clear that the method is restricted by the body of the claim to being used only on a patient experiencing sensations of chronic peripheral pain, where the chronic peripheral pain is defined as at least one of chronic neuropathic pain, failed back surgery syndrome, arachnoiditis, occipital neuralgia, peripheral pelvic pain, cardiac pain and back pain.

Once such patient has been identified, and once a leadless stimulator has been provided, the claimed method also now requires the step of "implanting the at least one leadless stimulator adjacent to at least one peripheral nerve of the patient" where the "peripheral nerve is responsible at least in part for the sensations of chronic pain experienced by the patient." Hence, as now claimed, it is clear that the body of Claim 1 does give life, vitality and meaning to the claim preamble, which limits the claim to methods for treating chronic peripheral pain. Similar limitations are found in amended Claim 15.

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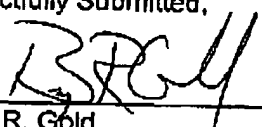
Because the Schulman et al. '452 patent does not show or suggest a method for treating chronic peripheral pain, as defined in the express claim language, for the class of patients identified by the claim language, it is submitted that the methods of treating chronic peripheral pain set forth in independent Claims 1 and 15, and all the dependent claims that depend therefrom, should be patentable. At best, Schulman et al. disclose a microstimulator device of a type that may be used with the present invention. However, Schulman et al. do not show or suggest using such microstimulator to treat chronic peripheral pain, i.e., to treat a patient experiencing sensations of chronic peripheral pain, where the chronic peripheral pain is defined as at least one of chronic neuropathic pain, failed back surgery syndrome, arachnoiditis, occipital neuralgia, peripheral pelvic pain, cardiac pain and back pain. All Schulman et al. teach is that their microstimulator may be used to stimulate muscles or nerves. However, no specific teachings are provided as to which patients should be treated using the microstimulator, nor which specific nerves of such patients should be stimulated. As such, Applicants invention --directed to a method of treating chronic peripheral pain-- resides in recognizing a new and nonobvious use for a microstimulator of the type disclosed by Schulman.

Conclusion

In view of the foregoing, it is respectfully submitted that the rejections have been overcome and that the pending claims are in condition for allowance. An indication of allowability of Claims 1-11 and 15-22 at an early date is thus earnestly solicited.

The Examiner is invited to telephone the undersigned, Bryant R. Gold, at his convenience should any issues remain after consideration and entry of this response, in order to permit early resolution of such issues.

Respectfully Submitted,


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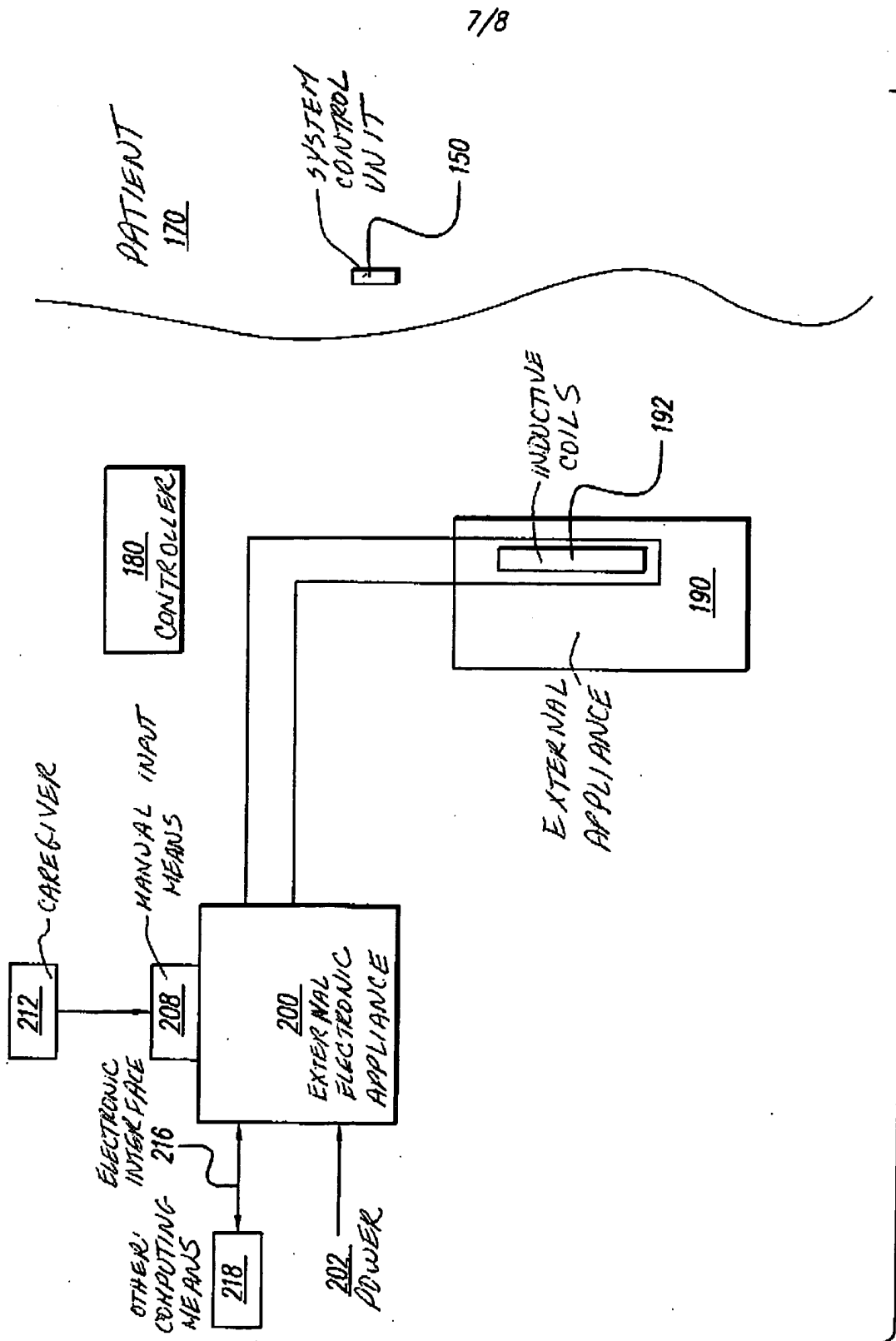


FIG. 5

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Attachments: Replacement Sheet for FIG. 5
 Annotated Sheet Showing Changes to FIG. 5

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